

**REMARKS**

Claims 1-14 are all the claims presently pending in the application.

To expedite prosecution, claims 1-4 have been amended to define more clearly and particularly the features of the invention.

Claims 5-14 have been added to claim additional features of the invention. No new matter is added.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1-4 stand rejected under 35 U.S.C. § 101.

Claim 4 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Allam (U.S. Publication No. 2004/0139400).

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Allam in view of Pruett (U.S. Patent No. 5,778,389).

These rejections are respectfully traversed in the following discussion.

**I. THE CLAIMED INVENTION**

The claimed invention is directed to a program for a method of transferring files that improves operability of file transfer in processing of multimedia files with a personal computer.

For example, independent claim 1 exemplarily defines a computer-readable medium tangibly embodying a program of recordable, computer-readable instructions executable by a digital processing apparatus to perform a method of transferring files, the method including, when a file stored in a first folder is selected to be stored into a second folder, comparing a filename of the selected file with a filename of each file already stored in the second folder. If the second folder contains no file having a filename same as the selected file, the method further includes storing the selected file into the second folder. If the second folder contains a file having a filename same as the selected file, the method further includes displaying thumbnail images and file information of the selected file and the file having the same filename together on a display device.

According to the present invention, if there is a file, in the target folder, having the same filename as a file selected to be transferred into the target folder, thumbnail images and file information of the selected file and the file having the same filename are displayed together on a display device. Thus, a decision whether or not to overwrite the file is promoted.

For example, in the case of a still image file, the still image in the folder is reduced and then displayed as its thumbnail image. Therefore, by comparing both of the thumbnail images, a decision whether or not to overwrite the file can be executed at a glance and operability of file transfer is improved (e.g., see specification at page 2, lines 20-28).

Somewhat similarly, in displaying thumbnail images and file information of two or more files together, the first frame of a movie included in a movie file can be displayed such that the contents of the file can be determined at a glance and operability of file transfer can be improved. Furthermore, by operating a thumbnail image (e.g., click

operation), the movie can be played back such that the contents of the file become clearer and operability of file transfer is further improved (e.g., see specification at page 3, lines 4-8).

Moreover, according to the present invention, even for audio files, the contents of which cannot easily be determined visually, icon images that indicate they are audio files can be displayed. According to the claimed invention, by operating the icon images (e.g., click operation), the audio is played back. Thus, a decision whether or not to overwrite an audio file can easily be executed, and operability of file transfer is improved (e.g., see specification at page 3, lines 19-23).

## **II. REJECTION UNDER 35 U.S.C. § 101**

Claims 1-4 stand rejected under 35 U.S.C. § 101 because the claims are directed to a program per se.

Claims 1-4 are amended to define more clearly and particularly the statutory subject matter of the claimed invention, in compliance with 35 U.S.C. § 101 and the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, which were published by the U.S. Patent Office on October 26, 2005.

Therefore, the Examiner is requested to reconsider and withdraw this rejection.

## **III. THE PRIOR ART REJECTIONS**

A. Claim 4 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Allam.

The Examiner alleges that Allam discloses all of the features of the claimed invention. Applicant respectfully submits, however, that there are features of the claimed

invention which are not disclosed or suggested by Allam. Therefore, Applicant traverses this rejection for at least the reasons set forth below.

First, while Applicant believes that all of the claims are patentable over the cited prior art, either individually or in combination, to expedite prosecution, Applicant notes that the Allam reference can be removed as prior art to the present application, thereby rendering each of the present rejections moot.

That is, Applicant submits that the Allam reference can be removed as prior art by perfecting the claim to foreign priority and filing a Declaration under 37 C.F.R. § 1.131 showing invention of the subject matter of the present application prior to the effective filing date of the Allam reference.

For example, the Allam reference is available as prior art only under § 102(e) as of the October 23, 2002 U.S. filing date of the parent Provisional Application from which Allam claims priority. On the other hand, the present application claims foreign priority from JP 2002-361998, which was filed on December 13, 2002. It is noted that the § 102(e) date of October 23, 2002 of Allam is one (1) month and twenty (20) days prior to the filing date of the present application's Japanese priority document on December 13, 2002.

Therefore, Allam can be removed as prior art under 35 U.S.C. § 102(e) by **(1)** perfecting Applicant's claim to foreign priority based on JP 2002-361998, which was filed on December 13, 2002, by filing a verified English translation thereof; and **(2)** filing a Declaration under 37 C.F.R. § 1.131 which swears behind the critical date (i.e., October 23, 2002) of Allam, by establishing invention of the subject matter of the present application before the Allam reference's effective § 102(e) prior art date of October 23, 2002.

Accompanying this Amendment is a verified English translation of the foreign priority document JP 2002-361998, thereby perfecting Applicant's claim to priority under 35 U.S.C. §119(a)-(d).

Also accompanying this Amendment is an un-executed Declaration under 37 C.F.R. § 1.131, for the Examiner's convenience, which swears behind the effective prior art date of the Allam reference. Shortly, Applicants will file the executed Declaration under 37 C.F.R. § 1.131 in the U.S. Patent Office upon execution by the inventor in the present application.

For the foregoing reasons, the Allam reference should be removed as prior art and the Examiner is requested to withdraw these rejections and to permit these claims to pass to immediate allowance.

Second, notwithstanding the above, Applicant respectfully submits that there are features of the claimed invention which clearly are not disclosed or suggested by Allam.

Turning to the merits of the rejections, the Examiner alleges that Allam discloses all of the features of independent claim 4 at Figure 7, and paragraphs [0034], [0052], and [0098]. However, Applicant respectfully disagrees with the Examiner's position.

While Applicant believes that all of the claims are patentable over the prior art of record, to expedite prosecution, claim 4 is amended merely to define more clearly and particularly the features of the claimed invention.

Turning to claim 4, the claimed invention is directed to transferring files. For example, independent claim 4 exemplarily defines a computer-readable medium tangibly embodying a program of recordable, computer-readable instructions executable by a digital processing apparatus to perform a method of transferring files, which includes:

*when an audio file stored in a first folder is selected to be stored into a second folder, comparing a filename of the selected file with a filename of each file already stored in the second folder and attaching a filename to the selected file and storing the selected file into the second folder;  
displaying an icon image on a display device, the icon image indicating that the file comprises audio, for the selected file and an audio file stored in the second folder; and  
playing back the audio upon operation to the icon image*  
(emphasis added).

According to the present invention, if there is a file, in the target folder, having the same filename as a file selected to be transferred into the target folder, thumbnail images and file information of the selected file and the file having the same filename are displayed together on a display device. Thus, a decision whether or not to overwrite the file is promoted.

For example, in the case of an audio file, the thumbnail image can be used to play back the audio such that a decision whether or not to overwrite the file can be executed easily and operability of file transfer is improved (e.g., see specification at page 2, lines 20-28).

In comparison, as the Examiner points out, Allam merely is directed to a system and method for displaying and viewing electronic information (see Office Action at page 4, last paragraph; see also Allam at paragraph [0034]). However, Allam has nothing to do with disclosed problems of transferring files and does not solve the problems being identified by the present invention.

Thus, for at least this reason, Allam clearly does not disclose or suggest all of the features of independent claim 4.

For the foregoing reasons, Allam does not disclose or suggest all of the features of the claimed invention. Therefore, the Examiner is requested to reconsider and withdraw this rejection and to permit claim 4 to pass to immediate allowance.

B. Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Allam in view of Pruett.

As mentioned above, the Allam reference should be removed as prior art and the Examiner is requested to withdraw this rejection and to permit these claims to pass to immediate allowance.

Notwithstanding the above, Applicant respectfully traverses this rejection.

The Examiner alleges that the combination of Allam and Pruett disclose or suggest all of the features of the claimed invention. Applicant respectfully submits, however, that there are features of the claimed invention which clearly are not disclosed or suggested by Allam and Pruett, either individually or in combination.

For example, independent claim 1 exemplarily defines a computer-readable medium tangibly embodying a program of recordable, computer-readable instructions executable by a digital processing apparatus to perform a method of transferring files, in which the method includes:

*when a file stored in a first folder is selected to be stored into a second folder, comparing a filename of the selected file with a filename of each file already stored in the second folder;*

*if the second folder contains no file having a filename same as the selected file, storing the selected file into the second folder; and*

*if the second folder contains a file having a filename same as the selected file, displaying thumbnail images and file information of the selected file and the file having the same filename together on a display device (emphasis added).*

That is, according to the claimed invention, in the case of a still image file, the still image in the folder is reduced and then displayed as its thumbnail image. Therefore, by comparing both of the thumbnail images, a decision whether or not to overwrite the file can be executed at a glance and operability of file transfer is improved (e.g., see specification at page 2, lines 20-28).

In comparison, Allam does not disclose or suggest “*displaying thumbnail images and file information of the selected file and the file having the same filename together on a display device*” such that a decision whether or not to overwrite the file can be executed at a glance and operability of file transfer is improved, as claimed.

Instead, Allam merely discloses that, when storing files in a network environment, a user is forced to wade through other people's organization schemes, resulting in frustration or missing documents. Allam discloses that, if someone makes a change to a document that is stored in ten places, you are left with dealing with outdated files or redistributing the changed document back to the other nine locations. Thus, Allam stores all files in one location and allows for a series of pointers to be stored in the program's organizer. In this way, Allam provides a category location that is a trait of a particular file rather than the file belonging to a certain category (e.g., see Allam at paragraph [0098]).

Moreover, Allam merely discloses that the electronic information displayed may include icons and hypertext which represent pictures or images, graphs or other statistical information, URLs, file names and file paths for information on the Internet or a networked computer, sidebars, related sections, and other structured elements. The information may also include icons representing and providing access to audio or



audiovisual clips. Activating these icons and hyperlinks will perform some action appropriate to their represented element (e.g., see Allam at paragraph [0052]).

However, Allam does not disclose or suggest that, when a file is to be stored, it is compared to other files and the icon showing the image file is displayed so that the user can determine at a glance whether to overwrite the file or not, according to the claimed invention.

On the other hand, claim 2 recites, *inter alia*, that, “*if at least one of the selected file and the file having the same filename comprises a movie file, displaying a first frame of the movie as the thumbnail image thereof on the display device, and playing back the movie upon operation to the thumbnail image*” (emphasis added).

According to the claimed invention, in displaying thumbnail images and file information of two or more files together, the first frame of a movie included in a movie file can be displayed such that the contents of the file can be determined at a glance and operability of file transfer can be improved. Furthermore, by operating a thumbnail image (e.g., click operation), the movie can be played back such that the contents of the file become clearer and operability of file transfer is further improved (e.g., see specification at page 3, lines 4-8).

However, Allam does not disclose or suggest that, when a file is to be stored, it is compared to other files and the icon showing the first frame of a movie file is displayed so that the user can determine at a glance whether to overwrite the file or not, and also so that the user can play the movie to easily determine whether to overwrite the file or not, according to the claimed invention.

Claim 3 recites, *inter alia*, that, “*if at least one of the selected file and the file having the same filename comprises an audio file, displaying an icon image as the*

*thumbnail image thereof on the display device, the icon image indicating that the file comprises audio, and playing back the audio upon operation to the icon image”*  
(emphasis added).

According to the present invention, even for audio files, the contents of which cannot easily be determined visually, icon images that indicate they are audio files can be displayed. According to the claimed invention, by operating the icon images (e.g., click operation), the audio is played back. Thus, a decision whether or not to overwrite an audio file can easily be executed, and operability of file transfer is improved (e.g., see specification at page 3, lines 19-23).

However, Allam does not disclose or suggest that, when a file is to be stored, it is compared to other files and the icon showing the audio file is displayed so that the user can play the audio to easily determine whether to overwrite the file or not, according to the claimed invention.

For the foregoing reasons, Allam and Pruett, either individually or in combination, do not disclose or suggest all of the features of the claimed invention. Therefore, the Examiner is requested to reconsider and withdraw this rejection and to permit claims 1-3 to pass to immediate allowance.

#### **IV. NEW CLAIMS**

New claims 5-14 are added to define more clearly and particularly the features of the claimed invention.

Applicant submits that claims 5-14 are patentable over the prior art of record for somewhat similar reasons as those set forth above.

**V. FORMAL MATTERS**

Applicants also request that the Examiner acknowledge receipt of and approve the formal drawings submitted on December 12, 2003.

**VI. CONCLUSION**


In view of the foregoing, Applicants submit that claims 1-14, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

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